

REMARKS

Claims 1 through 6 are pending in this Application. The specification has been amended to address formalistic issues for clarity. In addition, claims 1, 3, 5 and 6 have been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicant would note that claims 3, 5 and 6 have been placed in independent form and formalistic issues addressed in claims 5 and 6. Applicant submits that the present Amendment does not generate any new matter issue.

Claims 5 and 6 were rejected under the second paragraph of 35 U.S.C. §112.

In the statement of the rejection, the Examiner identified perceived antecedent basis issues. This rejection is traversed.

Initially, the mere lack of literal antecedent basis does not automatically trigger a rejection under the second paragraph of 35 U.S.C. §112 which is a legal issue. *Bose Corporation v. JBL, Inc.* 274 F.3d 1354, 61 USPQ2d 1216 (Fed. Cir. 2001).

At any rate, claims 5 and 6 have been amended to address the perceived antecedent basis issues identified by the Examiner, thereby overcoming the stated bases for the imposed rejection under the second paragraph of 35 U.S.C. §112. Applicant submits that one having ordinary skill in the art would have no difficulty understanding the scope of the claimed invention, particularly when reasonably interpreted in light of and consistent with the written description of the specification, which is the judicial standard. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870, 27 USPQ2d 1123 (Fed. Cir. 1993).

Applicant, therefore, submits that the imposed rejection of claims 5 and 6 under the second paragraph of 35 U.S.C. §112 is not viable and, hence, solicits withdrawal thereof.

Claims 1, 2 and 4 were rejected under 35 U.S.C. §102 for lack of novelty as evidenced by Otake.

In the statement of the rejection, the Examiner asserted that Otake discloses a semiconductor device corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art.

Dayco Prods., Inc. v. Total Containment, Inc. 329 F.3d 1358 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002).

There is a fundamental difference between the claimed semiconductor device and Otake's semiconductor device that scotches the factual determination that Otake discloses a semiconductor device identically corresponding to that claimed.

Specifically, the semiconductor device defined in claim 1 is limited such that two transistors share **one source region**. In other words, two **drain** regions of the two transistors are **separated** from each other.

Not so in Otake's semiconductor device. This should be apparent from Figs. 3 and 5, wherein it is shown that two NMOS transistors 5 and 6 **share** one drain **region 22**, and two **source** regions 17 of two transistors 5 and 6 are **separated** from each other.

The above argued structural difference between the claimed semiconductor device and Otake's semiconductor device is functionally significant. Specifically, in accordance with the

claimed invention, two transistors can independently output two signals from two drain regions, respectively. However, in Otake's system, two transistors 5 and 6 cannot independently output two signals from one drain region 22.

The above argued functionally significant structural difference between the claimed semiconductor device and Otake's semiconductor device undermines the factual determination that Otake discloses a semiconductor device identically corresponding to that claimed.

Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc., 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claims 1, 2 and 4 under 35 U.S.C. §102 for lack of novelty as evidenced by Otake is not factually viable and, hence, solicits withdrawal thereof.


Applicants acknowledge, with appreciation, the Examiner's indication that claims 3, 5 and 6 contain allowable subject matter. Claims 3, 5 and 6 have been placed in independent form and the formalistic issues identified with respect to claims 5 and 6 addressed. Based upon the argument submitted *supra*, Applicant submits that the imposed rejections have been overcome and that all pending claims are in condition for immediate allowance. Favorable consideration is, therefore, respectfully solicited.

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To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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